

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2011, has been entered.
2. Claims 1 and 3-6 are pending and under examination.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The rejection of claims 1 and 3-6 under 35 U.S.C. §103(a) as being unpatentable over Cosford WO '621 in view of Blake and Patani is maintained for reasons of record.
5. Applicants reiterate the arguments in traverse that were filed in responses dated January 25, 2010, and November 4, 2010. To summarize, Applicants dispute that the Office has established *prima facie* obviousness, based on an asserted lack of motivation to modify the prior art compounds of Cosford WO '621 to arrive at the claimed invention. Applicants assert 1) that the substitution of a methyl group for a hydrogen at the 6-position of the pyridine ring (where the alkynyl group occupies the 2-position) is not *prima facie* obvious; and 2) that the Office did not provide motivation for the specific isotopic substitutions encompassed by the instant claims.
6. Applicants are reminded that under MPEP 2144.09 compounds with close structural similarities and similar utilities are *prima facie* obvious. As stated there, it is the expectation of similar properties that provides the motivation for the artisan to make these variations. With respect to the methyl-for-hydrogen substitution, the *in re Wood* case specifically established that

compounds which differ by the substitution of CH<sub>3</sub> for H are *prima facie* obvious. *In re Wood, Whitaker, Sterling, and Ohta* 199 USPQ 137 (C.C.P.A. 1978).

7. With respect to radiolabeling, the “general premise” (as Applicants put it) of Blake, that stable isotopes are often useful as tracers for drug distribution and metabolism studies, is sufficient to provide a reasonable expectation of success that isotopic substitution will produce useful compounds. Applicants contend that the Office has not shown a specific motivation to radiolabel the formula I compound at the oxime R position. In support of this contention, Applicants note that the compound has 15 carbon atoms, 16 hydrogens, 2 nitrogens, and one oxygen which might have been labeled. However, this is a “straw-man” argument, because substitution of one of the ring atoms, or of a hydrogen bound to a ring atom, would require a multi-step synthesis of the pyridine or cyclohexene ring – a far more arduous and expensive project than substitution at a non-ring atom. Once the ring atoms are omitted, there are at most 8 positions that could be considered for radiolabelling. Choosing from among these 8 constitutes, in the language of MPEP 2142 (citing KSR), “choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.

8. For these reasons Applicants' arguments, although fully considered, have not been found persuasive. Therefore, the rejection is maintained.

### ***Conclusion***

**9. No claim is allowed.**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Reese, whose telephone number is (571)270-5277. The examiner can normally be reached on M - Th, 8 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571)-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Heidi Reese/  
Examiner, Art Unit 1625

/Janet L. Andres/  
Supervisory Patent Examiner, Art Unit 1625